

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jeff EDER

Serial No.: 10/750,792

Filed: January 3, 2004

For: AN AUTOMATED METHOD OF AND SYSTEM FOR IDENTIFYING, MEASURING AND ENHANCING CATEGORIES OF VALUE FOR A VALUE CHAIN

Group Art Unit: 3691

Examiner: Sigfried Chencinski

Brief on Appeal

Sir or Madam:

The Appellant respectfully appeals the rejection of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181, claim 182, claim 183, claim 184, claim 185, claim 186, claim 187, claim 188, claim 189, claim 190, claim 191, claim 192, claim 193, claim 194, claim 195, claim 196 and claim 197 in the November 17, 2008 Office Action for the above referenced application. The Table of Contents is on page 2 of this paper.

This brief on appeal is being filed in response to the notice of non compliant appeal brief mailed on August 14, 2009.

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1. Real party in interest

Asset Reliance, Inc. (dba Asset Trust, Inc.) is the Appellant and the owner of 100% interest in the above referenced patent application.

2. Related appeals

An Appeal for U.S. Patent Application 09/761,670 filed on January 19, 2001 may be affected by or have a bearing on this appeal. An Appeal for U.S. Patent Application 10/743,417 filed on December 22, 2003 may be affected by or have a bearing on this appeal. An Appeal for U.S. Patent Application 11/278,419 filed on April 1, 2006 may be affected by or have a bearing on this appeal.

3. Status of Claims

Claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181, claim 182, claim 183, claim 184, claim 185, claim 186, claim 187, claim 188, claim 189, claim 190, claim 191, claim 192, claim 193, claim 194, claim 195, claim 196 and claim 197 are rejected and are the subject of this appeal. Claims 1 – 174 are cancelled (they were cancelled before the first Office Action). No other claims are pending.

4. Status of Amendments

There are no amendments pending.

5. Summary of Claimed Subject Matter

One embodiment of an automated method of and system for identifying, measuring and enhancing categories of value for a value chain is best depicted in Figure 1 – 10 of the specification. Figure 1 gives an overview of the major processing steps which include preparing data for use in processing, identifying keywords, transforming the data into a set of models representative of organization financial performance before using one or more of the weights from said models as a keyword relevance indicator.

Independent Claim 175 - A first embodiment of the system for identifying, measuring and enhancing categories of value for a value chain is exemplified in independent claim 175 where an article of manufacture instructs a computer system to integrate data representative of an organization from a plurality of databases and then transforms the integrated data into models of organization financial performance by a category of value. The weights that are output from

said models are useful as indicators of keyword relevance. Support for the specific steps contained in the claim can be found in the specification and drawings as detailed below:

The computer system is described in FIG. 3, reference numbers 100, 110 – 118, 120 – 128 and 130 – 138 and line 16, page 15 through line 4, page 17 of the specification.

a) integrating a plurality of data from a plurality of organization related systems, user input and an Internet in accordance with a common schema and an xml metadata standard - the acquisition and integration of data is described in FIG. 5A reference numbers 202, 203, 207, 208, 209 and 211, FIG 5B, reference numbers 221, 222, 225, 226, 209 and 211, FIG 5C, reference numbers 241, 242, 209 and 211; FIG 5D, reference numbers 261, 262, 266, 267, 268 and 269, 209 and 211, FIG. 5E, reference numbers 277, 278, 279, 280, 281 and 282 line 16, page 27; through line 9, page 37 and line 19, page 37 through line 33, page 41 of the specification;

b) obtaining one or more keywords and a set of classification rules for each keyword from a user - the user (20) identifies keywords and establishes metadata mapping as described in FIG. 5D, reference number 265 and line 10, page 37 through line 18, page 37 of the specification;

c) searching for a plurality of keywords on the Internet, storing a location for each identified keyword, counting and classifying each stored keyword and creating one or more keyword performance indicators - the search for keywords, the identification of keyword locations, the analysis of the keyword data and the development of keyword performance indicators (i.e. counts of classified hits) found on the Internet is described in FIG. 5D, reference numbers 266 and 267 and line 19, page 37 and line 28, page 38 of the specification;

d) developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators – transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the current operation category of value above is described in FIG. 5F reference numbers 291, 292, 293, 294, 295, 296 and 297, FIG. 6A, reference numbers 303, 304, 305, 306, 307, 308, 309 and 310; FIG. 6B reference numbers 321, 323, 328, 329, 330, 331 and 333, FIG. 6C reference numbers 341, 342, 343, 345, 346, 347, 348, 349 and 350, line 29, page 38 through line 14, page 51 and line 5, page 53 through line 33, page 60 of the specification . Keyword indicator impact is determined for the current operation and the other categories of value by multiplying the percentage contribution of each keyword indicator to each element of value summary by the quantified element of value impact for all elements of value (see Table 7, page 19 for general procedure). Transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the real option category of value is

described in FIG 6C reference number 325, 326, 327 and line 15, page 51 through line 4, page 53 of the specification. Transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the market sentiment category of value is described in FIG. 7 reference numbers 404, 405, 410 and line 1, page 61 through line 15, page 65 of the specification.

e) using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization - the quantified impact's on organization financial performance are measures of relevance as discussed in line 1, page 12 through line 16, page 12.

f) where keyword performance indicators are linked together when they are not independent – as described in FIG. 6A, reference numbers 306 and 308 and line 24, page 48 through line 15, page 50 of the specification.

Claim 176 - The limitations associated with dependent claim 176 are described in a number of places including FIG. 5A, reference number 203 and line 12, page 29 through line 27, page 29 of the specification.

Claim 177 - The limitations and activities associated with dependent claim 177 are described in FIG. 1 reference number 50, FIG. 5A reference numbers 50, 202, 203, 207, 208, 209 and 211, FIG 5B, reference numbers 50, 221, 222, 225, 226, 209 and 211, FIG 5C, reference numbers 50, 241, 242, 209 and 211; FIG 5D, reference numbers 50, 261, 262, 266, 267, 268 and 269, 209 and 211, FIG. 5E, reference numbers 50, 277, 278, 279, 280, 281 and 282 line 16, page 27; through line 9, page 37 and line 19, page 37 through line 33, page 41.

Claim 178 - The limitations associated with dependent claim 178 are described in a number of places including FIG. 1 reference numbers 5, 10, 15, 20, 30 and 35, line 1, page 21 through line 20, page 21 and line 19, page 26 through line 24, page 26 of the specification.

Claim 179 - The limitations associated with dependent claim 179 are described in a number of places including FIG. 5A, reference number 203, and line 1, page 29, through line 6, page 30 of the specification.

Claim 180 - The limitations associated with dependent claim 180 are described in a number of places including FIG. 2 reference numbers 140 – 169 and line 28, page 14 through line 7, page 15 of the specification.

Claim 181 - The limitations associated with dependent claim 181 are described in a number of places including FIG. 5D, reference number 265 and line 10, page 37 through line 18, page 37 of the specification.

Claim 182 - The limitations associated with dependent claim 182 are described in a number of places including line 25, page 25 through line 33, page 25 of the specification.

Independent Claim 183 - A second embodiment of the system for identifying, measuring and enhancing categories of value for a value chain is exemplified in independent claim 183 where a process uses a computer system to integrate data representative of an organization from a plurality of databases and then transforms the integrated data into models of organization financial performance by a category of value. The weights that are output from said models are useful as indicators of keyword relevance. Support for the specific steps contained in the claim can be found in the specification and drawings as detailed below:

a) integrating a plurality of data from a plurality of organization related systems, user input and an Internet in accordance with a common schema and an xml metadata standard - the acquisition and integration of data is described in FIG. 5A reference numbers 202, 203, 207, 208, 209 and 211, FIG 5B, reference numbers 221, 222, 225, 226, 209 and 211, FIG 5C, reference numbers 241, 242, 209 and 211; FIG 5D, reference numbers 261, 262, 266, 267, 268 and 269, 209 and 211, FIG. 5E, reference numbers 277, 278, 279, 280, 281 and 282 line 16, page 27; through line 9, page 37 and line 19, page 37 through line 33, page 41 of the specification;

b) obtaining one or more keywords and a set of classification rules for each keyword from a user - the user (20) identifies keywords and establishes metadata mapping as described in FIG. 5D, reference number 265 and line 10, page 37 through line 18, page 37 of the specification;

c) searching for a plurality of keywords on the Internet, storing a location for each identified keyword, counting and classifying each stored keyword and creating one or more keyword performance indicators - the search for keywords, the identification of keyword locations, the analysis of the keyword data and the development of keyword performance indicators (i.e. counts of classified hits) found on the Internet is described in FIG. 5D, reference numbers 266 and 267 and line 19, page 37 and line 28, page 38 of the specification;

d) developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators – transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the current operation category of value above is described in FIG. 5F reference numbers 291, 292, 293, 294, 295, 296 and 297, FIG. 6A, reference numbers 303, 304, 305, 306, 307, 308, 309 and 310; FIG. 6B reference numbers 321, 323, 328, 329, 330, 331 and 333, FIG. 6C reference numbers 341, 342, 343, 345, 346, 347, 348, 349 and 350, line 29, page 38

through line 14, page 51 and line 5, page 53 through line 33, page 60 of the specification . Keyword indicator impact is determined for the current operation and the other categories of value by multiplying the percentage contribution of each keyword indicator to each element of value summary by the quantified element of value impact for all elements of value (see Table 7, page 19 for general procedure). Transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the real option category of value is described in FIG 6C reference number 325, 326, 327 and line 15, page 51 through line 4, page 53 of the specification. Transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the market sentiment category of value is described in FIG. 7 reference numbers 404, 405, 410 and line 1, page 61 through line 15, page 65 of the specification. The process for transforming data into models is the same process

e) using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization. As discussed in line 1, page 12 through line 16, page 12 the quantified impact's on organization financial performance are measures of relevance to determining the overall financial performance.

f) where keyword performance indicators are linked together when they are not independent – as described in FIG. 6A, reference numbers 306 and 308 and line 24, page 48 through line 15, page 50 of the specification.

The computer system is described in FIG. 3, reference numbers 100, 110 – 118, 120 – 128 and 130 – 138 and line 16, page 15 through line 4, page 17 of the specification.

Claim 184 - The limitations associated with dependent claim 184 are described in a number of places including FIG. 5A, reference number 203 and line 12, page 29 through line 27, page 29 of the specification.

Claim 185 - The limitations associated with dependent claim 185 are described in a number of places including FIG. 1 reference numbers 5, 10, 15, 20, 30 and 35, line 1, page 21 through line 20, page 21 and line 19, page 26 through line 24, page 26 of the specification.

Claim 186 - The limitations associated with dependent claim 186 are described in a number of places including FIG. 5A, reference number 203, and line 1, page 29, through line 6, page 30 of the specification.

Claim 187 - The limitations associated with dependent claim 187 are described in a number of places including FIG. 5D, reference number 265 and line 10, page 37 through line 18, page 37 of the specification.

Independent Claim 188 - A third embodiment of the system for identifying, measuring and enhancing categories of value for a value chain is exemplified in independent claim 188 where a computer system integrates data representative of an organization from a plurality of databases and then transforms the integrated data into models of organization financial performance by a category of value. The weights that are output from said models are useful as indicators of keyword relevance. Support for the claim can be found in the specification and drawings as detailed below:

The computer system is described in FIG. 3, reference numbers 100, 110 – 118, 120 – 128 and 130 – 138 and line 16, page 15 through line 4, page 17 of the specification.

a) integrating a plurality of data from a plurality of organization related systems, user input, an Internet and one or more external databases in accordance with a common schema and an xml metadata standard - the acquisition and integration of data is described in FIG. 5A reference numbers 202, 203, 207, 208, 209 and 211, FIG 5B, reference numbers 221, 222, 225, 226, 209 and 211, FIG 5C, reference numbers 241, 242, 209 and 211; FIG 5D, reference numbers 261, 262, 266, 267, 268 and 269, 270, 271, 209 and 211, FIG. 5E, reference numbers 277, 278, 279, 280, 281 and 282 line 16, page 27; through line 9, page 37 and line 19, page 37 through line 33, page 41 of the specification;

b) obtaining one or more keywords and a set of classification rules for each keyword from a user - the user (20) identifies keywords and establishes metadata mapping as described in FIG. 5D, reference number 265 and line 10, page 37 through line 18, page 37 of the specification;

c) searching for a plurality of keywords on the Internet, storing a location for each identified keyword, counting and classifying each stored keyword and creating one or more keyword performance indicators - the search for keywords, the identification of keyword locations, the analysis of the keyword data and the development of keyword performance indicators (i.e. counts of classified hits) found on the Internet is described in FIG. 5D, reference numbers 266 and 267 and line 19, page 37 and line 28, page 38 of the specification;

d) developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators – transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the current operation category of value above is described in FIG. 5F reference numbers 291, 292, 293, 294, 295, 296 and 297, FIG. 6A, reference numbers 303, 304, 305, 306, 307, 308, 309 and 310; FIG. 6B reference numbers 321, 323, 328, 329, 330, 331 and 333, FIG. 6C reference numbers 341, 342, 343, 345, 346, 347, 348, 349 and 350, line 29, page 38 through line 14, page 51 and line 5, page 53 through line 33, page 60 of the specification .

Keyword indicator impact is determined for the current operation and the other categories of value by multiplying the percentage contribution of each keyword indicator to each element of value summary by the quantified element of value impact for all elements of value (see Table 7, page 19 for general procedure). Transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the real option category of value is described in FIG 6C reference number 325, 326, 327 and line 15, page 51 through line 4, page 53 of the specification. Transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the market sentiment category of value is described in FIG. 7 reference numbers 404, 405, 410 and line 1, page 61 through line 15, page 65 of the specification. The process for transforming data into models is the same process

e) using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization. As discussed in line 1, page 12 through line 16, page 12 the quantified impact's on organization financial performance are measures of relevance to determining the overall financial performance.

f) where keyword performance indicators are linked together when they are not independent – as described in FIG. 6A, reference numbers 306 and 308 and line 24, page 48 through line 15, page 50 of the specification.

Claim 189 - The limitations associated with dependent claim 189 are described in a number of places including FIG. 5A, reference number 203 and line 12, page 29 through line 27, page 29 of the specification.

Claim 190 - The limitations associated with dependent claim 190 are described in a number of places including FIG. 1 reference numbers 5, 10, 15, 20, 25, 30 and 35, line 1, page 21 through line 20, page 21 and line 19, page 26 through line 24, page 26 of the specification.

Claim 191 - The limitations associated with dependent claim 191 are described in a number of places including FIG. 5A, reference number 203, and line 1, page 29, through line 6, page 30 of the specification.

Claim 192 - The limitations associated with dependent claim 192 are described in a number of places including FIG. 5D, reference number 265 and line 10, page 37 through line 18, page 37 of the specification.

Independent Claim 193 - A fourth embodiment of the system for identifying, measuring and enhancing categories of value for a value chain is exemplified in independent claim 193 where a process uses a computer system to integrate data representative of an organization from a

plurality of databases and then transforms the integrated data into models of organization financial performance by a category of value. The weights that are output from said models are useful as indicators of keyword relevance. Support for the claim can be found in the specification and drawings as detailed below:

The computer system is described in FIG. 3, reference numbers 100, 110 – 118, 120 – 128 and 130 – 138 and line 16, page 15 through line 4, page 17 of the specification.

a) integrating a plurality of data from a plurality of organization related systems, user input, an Internet and one or more external databases in accordance with a common schema and an xml metadata standard - the acquisition and integration of data is described in FIG. 5A reference numbers 202, 203, 207, 208, 209 and 211, FIG 5B, reference numbers 221, 222, 225, 226, 209 and 211, FIG 5C, reference numbers 241, 242, 209 and 211; FIG 5D, reference numbers 261, 262, 266, 267, 268 and 269, 270, 271, 209 and 211, FIG. 5E, reference numbers 277, 278, 279, 280, 281 and 282 line 16, page 27; through line 9, page 37 and line 19, page 37 through line 33, page 41 of the specification;

b) obtaining one or more keywords and a set of classification rules for each keyword from a user - the user (20) identifies keywords and establishes metadata mapping as described in FIG. 5D, reference number 265 and line 10, page 37 through line 18, page 37 of the specification;

c) searching for a plurality of keywords on the Internet, storing a location for each identified keyword, counting and classifying each stored keyword and creating one or more keyword performance indicators - the search for keywords, the identification of keyword locations, the analysis of the keyword data and the development of keyword performance indicators (i.e. counts of classified hits) found on the Internet is described in FIG. 5D, reference numbers 266 and 267 and line 19, page 37 and line 28, page 38 of the specification;

d) developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators – transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the current operation category of value above is described in FIG. 5F reference numbers 291, 292, 293, 294, 295, 296 and 297, FIG. 6A, reference numbers 303, 304, 305, 306, 307, 308, 309 and 310; FIG. 6B reference numbers 321, 323, 328, 329, 330, 331 and 333, FIG. 6C reference numbers 341, 342, 343, 345, 346, 347, 348, 349 and 350, line 29, page 38 through line 14, page 51 and line 5, page 53 through line 33, page 60 of the specification . Keyword indicator impact is determined for the current operation and the other categories of value by multiplying the percentage contribution of each keyword indicator to each element of value summary by the quantified element of value impact for all elements of value (see Table 7,

page 19 for general procedure). Transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the real option category of value is described in FIG 6C reference number 325, 326, 327 and line 15, page 51 through line 4, page 53 of the specification. Transforming the data obtained in steps a, b and c above into a model that identifies the impact of the elements of value on the market sentiment category of value is described in FIG. 7 reference numbers 404, 405, 410 and line 1, page 61 through line 15, page 65 of the specification. The process for transforming data into models is the same process *e) using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization.* As discussed in line 1, page 12 through line 16, page 12 the quantified impact's on organization financial performance are measures of relevance to determining the overall financial performance.

Claim 194 - The limitations associated with dependent claim 194 are described in a number of places including FIG. 5A, reference number 203 and line 12, page 29 through line 27, page 29 of the specification.

Claim 195 - The limitations associated with dependent claim 195 are described in a number of places including FIG. 1 reference numbers 5, 10, 15, 20, 25, 30 and 35, line 1, page 21 through line 20, page 21 and line 19, page 26 through line 24, page 26 of the specification.

Claim 196 - The limitations associated with dependent claim 196 are described in a number of places including FIG. 5A, reference number 203, and line 1, page 29, through line 6, page 30 of the specification.

Claim 197 - The limitations associated with dependent claim 197 are described in a number of places including FIG. 5D, reference number 265 and line 10, page 37 through line 18, page 37 of the specification.

6. Grounds of rejection to be reviewed on appeal

Issue 1 - Whether claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 are patentable under 35 U.S.C. 103(a) given U.S. Patent 6,012,053 (hereinafter, Pant) in view of U.S. Patent 5,812,988 (hereinafter, Sandretto)?

Issue 2 – Whether claim 183, claim 184, claim 185, claim 186 and claim 187 are patentable under 35 U.S.C. 103(a) given Pant in view of Sandretto?

Issue 3 – Whether claim 188, claim 189, claim 190, claim 191 and claim 192 are patentable under 35 U.S.C. 103(a) given Pant in view of Sandretto?

Issue 4 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 are patentable under 35 U.S.C. 103(a) given Pant in view of Sandretto?

Issue 5 - Whether claim 183, claim 184, claim 185, claim 186 and claim 187 represent patentable subject matter under 35 U.S.C. 101?

Issue 6 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 represent patentable subject matter under 35 U.S.C. 101?

Issue 7 - Whether claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 are enabled under 35 U.S.C. 112, first paragraph?

Issue 8 – Whether claim 183, claim 184, claim 185, claim 186 and claim 187 are enabled under 35 U.S.C. 112, first paragraph?

Issue 9 – Whether claim 188, claim 189, claim 190, claim 191 and claim 192 are enabled under 35 U.S.C. 112, first paragraph?

Issue 10 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 are enabled under 35 U.S.C. 112, first paragraph?

Issue 11 - Whether claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 are indefinite under 35 U.S.C. 112, second paragraph?

Issue 12 – Whether claim 183, claim 184, claim 185, claim 186 and claim 187 are indefinite under 35 U.S.C. 112, second paragraph?

Issue 13 – Whether claim 188, claim 189, claim 190, claim 191 and claim 192 are indefinite under 35 U.S.C. 112, second paragraph?

Issue 14 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 are indefinite under 35 U.S.C. 112, second paragraph?

7. The Argument

Grouping of Claims

For each ground of rejection which Appellant contests herein which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand and fall together.

Issue 1 - Whether claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 are patentable under 35 U.S.C. 103(a) given U.S. Patent 6,012,053 (hereinafter, Pant) in view of U.S. Patent 5,812,988 (hereinafter, Sandretto)?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the cited combination of teachings (Pant and Sandretto) and the arguments related to the cited combination of teachings fail to establish a prima facie case of obviousness for every rejected claim as detailed below.

Errors 1 through 13 – It is well established that: *“in determining the difference between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious but whether the claimed invention as a whole would have been obvious.”* Furthermore, it is well established that: *A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).* Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the cited references teach away from the invention described in claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 include:

Error #1) A failure to acknowledge the fact that Pant teaches away from determining keyword relevance. Pant teaches away from every aspect of the claimed invention. Claim 175 describes the development of keyword relevance measures. Pant teaches away by teaching a method that identifies the relevance of a web page or document retrieved by a search (Pant, Column 1, Line 65 through Column 2, Line 25). By exclusively teaching methods that teach away from the claimed invention, Pant provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #2) A failure to acknowledge the fact that Pant teaches away from the claimed method of determining keyword relevance. Pant teaches away from every aspect of the claimed invention. Claim 175 describes the development of keyword relevance measures based on the quantified impact on enterprise value. Pant teaches away by teaching a method that identifies relevance measures based on user identified factors and weights (Pant, abstract, Column 2, line 25 through line 36). By exclusively teaching methods that teach away from the claimed invention, Pant provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #3) A failure to acknowledge the fact that Sandretto teaches away from the claimed enterprise value model. Sandretto teaches away from every aspect of the claimed

invention. Claim 175 teach and rely on the fact that there are at least three ways to increase the value of a business: increase the value of current operation cash flow, increase the value of market sentiment and increase the value of the enterprise real options. Sandretto teaches away by teaching that there is only one category of enterprise value, cash flow (see table below).

Enterprise value model per 10/750,792	Enterprise value model per Sandretto
Enterprise value = value of current operation cash flow + value of market sentiment + value of real options	Value of cash flow

By exclusively teaching methods that teach away from the claimed invention, Sandretto provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #4) A failure to acknowledge that Sandretto teaches away from the claimed market efficiency assumptions. Sandretto teaches away from every aspect of the claimed invention. Claim 175 describes a model development method that does not rely on any assumptions about market efficiency. Sandretto teaches away by teaching an analysis method that relies on the efficient market hypothesis (see Sandretto, Column 9, Line 54 through Line 60). By exclusively teaching methods that teach away from the claimed invention, Sandretto provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #5) A failure to acknowledge the fact that Sandretto teaches away from the claimed method of quantifying the impact of keyword relevance measures on enterprise value. Sandretto teaches away from every aspect of the claimed invention. Claim 175 describes a process that uses a series of model to identify the previously unknown impact of an element of value or keyword relevance measure on enterprise value. Sandretto teaches away by teaching that reliance on predetermined models to forecast the financial performance of an asset when given a set of external, economic variables (see Sandretto, abstract and Column 9, Line 20 through Line 25). By exclusively teaching methods that teach away from the claimed invention, Sandretto provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #6) A failure to acknowledge the fact that Sandretto teaches away from the claimed

development of category of value models. Sandretto teaches away from every aspect of the claimed invention. Claim 175 describes the transformation of data representative of a business operation and its elements of value into models that have utility in keyword relevance determination, business forecasting and performance management. Sandretto teaches away by teaching the use of a process that only iterates the data that is provided by a user (see Sandretto, Column 3, Line 21 through Line 37). By exclusively teaching methods that teach away from the claimed invention, Sandretto provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #7) A failure to acknowledge the fact that Pant teaches away from the claimed development of category of value models. Pant teaches away from every aspect of the claimed invention. Claim 175 describes the transformation of data representative of a business operation and its elements of value into models that have utility in keyword relevance determination, business forecasting and performance management. Pant teaches away by teaching a method that does not transform data or develop any models. The Pant invention is limited to sorting a set of search results based on user input regarding relevance (see Pant, abstract, FIG. 3, Column 5, Line 60 through Column 6, Line 15). By exclusively teaching methods that teach away from the claimed invention, Pant provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #8) A failure to acknowledge the Pant teaches away from the claimed use of search in developing keyword relevance measures. Pant teaches away from every aspect of the claimed invention. Claims 175 describes a process for developing keyword relevance measures that relies on a search that identifies keyword characteristics (i.e. location, classified count, etc.) Pant teaches away by teaching a method that relies on a search that identifies potentially relevant results (see Pant, abstract, FIG. 3, Column 5, Line 60 through Column 6, Line 15). By exclusively teaching methods that teach away from the claimed invention, Pant provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #9) A failure to acknowledge that Sandretto teaches away from the claimed level of analysis. Sandretto teaches away from every aspect of the claimed invention. Claim 175 describes the development and use of a plurality of models that quantify the impact of one

or more elements of value on one or more categories of enterprise value. Elements of value are comprised of a plurality of items that are grouped together for modeling, analysis and management. Sandretto teaches away by teaching item (aka asset) level analysis (see Sandretto, abstract, Column 3, Line 8 through Line 11). By exclusively teaching methods that teach away from the claimed invention, Sandretto provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #10) Failure to acknowledge that Sandretto teaches away from the claimed statistical analysis. Sandretto teaches away from every aspect of the claimed invention. Claim 175 describes the development and use of a statistical model of element of value impact on the components of enterprise value. Sandretto teaches away by teaching a method that purports to determine the actual value of each item (aka asset) instead of identifying a statistical model of element of value impact (see Sandretto, Column 8, Lines 52 - 53). By exclusively teaching methods that teach away from the claimed invention, Sandretto provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #11) Failure to acknowledge that Sandretto teaches away from the claimed role of elements of value. Sandretto teaches away from every aspect of the claimed invention. The claimed invention teaches that element of value performance drives the categories of value and the components of value (i.e. revenue). Sandretto teaches away by teaching that external factors (i.e. industrial production levels) determine revenue, expense and cash flow by item (see Sandretto, Column 37, line 32 – Column 38, line 51).

Aspect	Sandretto teaches	10/750,792 teaches
Revenue	Driven by external factors	Driven by element of value performance
Expense	Driven by external factors	Driven by element of value performance
Capital Change	No relevant teaching	Driven by element of value performance
Cash Flow	Driven by external factors	Driven by element of value performance
Real options	Option values are driven by variance	Driven by element of value performance
Market sentiment	That market sentiment does not exist	Driven by element of value performance

By exclusively teaching methods that teach away from the claimed invention, Sandretto provides additional evidence of the novelty, non-obviousness and newness of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Error #12) Failure to acknowledge that Pant teaches away from the claimed method of

data management. Pant teaches away from every aspect of the claimed invention. Claims 176 and 177 teach that some data are pre-specified for integration and conversion from a plurality of systems. Claim 179 describes the use of a schema that identifies non relevant attributes. Pant teaches away by teaching that relevant material is only identified after a search and user input (see Pant, abstract, FIG. 3, Column 5, Line 60 through Column 6, Line 15). By exclusively teaching methods that teach away from the claimed invention, Pant provides additional evidence of the novelty, non-obviousness and newness of claim 176, claim 177 and claim 179.

Error #13) Failure to acknowledge that Sandretto teaches away from the claimed method of data management. Claims 176 and 177 teach that some data are pre-specified for integration and conversion from a plurality of systems. Sandretto teaches away by teaching that only 3 variables are required and that the user can provide the required data input (see Sandretto, Column 3, Line 21 through Line 25). Furthermore, values for the three variables are not generally found in the claimed systems. By exclusively teaching methods that teach away from the claimed invention, Sandretto provides additional evidence of the novelty, non-obviousness and newness of claim 176 and claim 177.

Errors 14 through 27 – It is well established that *“when determining whether a claim is obvious, an examiner must make ‘a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.’ In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995). Thus, ‘obviousness requires a suggestion of all limitations in a claim.’ CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (CCPA 1974))* Furthermore, the Board of Patent Appeal and Interferences recently confirmed (In re Wada and Murphy, Appeal No. 2007- 3733) that a proper, post KSR obviousness determination still requires that an examiner must make *“a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.” In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added).* In other words, obviousness still requires a suggestion of all the limitations in a claim. Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the cited documents do not teach one or more limitations of the claimed invention include:

Errors #14, #15, #16, #17, #18, #19 and #20) Failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitation of claim 175 (affects claims 176, 177, 178, 179, 180, 181 and 182), including:

a) *integrating a plurality of data from a plurality of organization related systems, user input*

and an Internet in accordance with a common schema and an xml metadata standard (#14),

b) obtaining one or more keywords and a set of classification rules for each keyword from a user (#15),

c) searching for a plurality of keywords on the Internet and storing a location for each identified keyword (#16),

d) counting and classifying each stored keyword (#17),

e) creating one or more keyword performance indicators where keyword performance indicators are linked together when they are not independent (#18),

f) developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators (#19), and

g) using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization (#20).

Error #21) Failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 176, including: *where some data are pre-specified for integration and conversion.*

Error #22) Failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 177, including: *integrated enterprise data that are stored in an application database in accordance with a common schema.*

Error #23) Failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 178, including: *obtaining data from systems are selected from the group consisting of advanced financial systems, basic financial systems, alliance management systems, brand management systems, customer relationship management systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling systems, supply chain systems, quality control systems, purchasing systems, risk management systems and combinations thereof.*

Error #24) Failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 179, including: *a common schema that identifies*

data designations selected from the group consisting of components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof.

Error #25) Failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 180, including: *storing a plurality of converted data in one or more tables to support organization processing.*

Error #26) Failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 181, including: *wherein each keyword maps to the common schema.*

Error #27) Failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitations of claim 182, including: *wherein the program storage device comprises one or more intelligent agents.*

Errors 28 through 31 – It is well established that when “*the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)*”. Errors in the claim rejections caused by the apparent failure to acknowledge the fact that changes in the principles of operation of Sandretto will be required to replicate the invention described in claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 include:

Error #28) One principle of operation that Sandretto relies on is that external, economic conditions determine enterprise revenue levels, enterprise expense levels and item cash flow (see Sandretto, Column 37, Lines 37 – 58). This principle of operation would have to be changed to replicate the functionality of the claimed invention and recognize the fact that element of value performance determines enterprise revenue levels, enterprise expense levels and cash flow.

Error #29) A second principle of operation that Sandretto relies on is that: the financial performance of each asset of a portfolio or firm is a known function of a plurality of economic variables (see Sandretto, abstract and Column 9, L 20 through L 25) that are incorporated in pre-defined models that Sandretto relies on. This principle of operation would have to be changed to replicate the functionality of the claimed invention that teaches and relies on the principle that the impact of an element of value on a firm is unknown and must be discovered by modeling. The Appellant notes that this modification

requires the Sandretto invention to use an approach (see Table below) that is exactly opposite of the one it relies on and destroy its ability to function.

	Sandretto	10/750,792
Known parameter(s)	Asset financial performance as a function of economic variables	Discount rate
Unknown parameter(s)	Discount rate	Element of value impact

Error #30) A third principle of operation that Sandretto relies on is the calculation of the actual value of each item (see Sandretto, Column 8, Lines 52 - 53). This principle of operation would have to be changed to replicate the functionality of the claimed invention and recognize the fact a statistical model of the contribution of each element of value is developed without calculating the value of each item (aka asset).

Error #31) Another principle of operation that Sandretto relies on is that discount rates are determined by iteration where said iteration takes place as required to back fit the value of a plurality of items (aka assets) to a known portfolio value (see Sandretto, Column 3, Line 25). This principle of operation would have to be changed to replicate the functionality of the claimed invention which relies on the development and use of discount rates that are analytically determined.

Because the required modifications of the Sandretto invention would change several of its principles of operation, the prima facie case of obviousness cannot be properly made.

Errors 32 through 34 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that changes in the principles of operation of Pant will be required to replicate the invention described in claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 include:

Error #32) One principle of operation that Pant relies on is that relevance is defined by user identified factors and weights (Pant, abstract, Column 2, line 25 through line 36). This principle of operation would have to be changed to replicate the functionality of the claimed invention that teaches and relies on the principle that keyword relevance is measured using the quantified impact on enterprise value.

Error #33) A second principle of operation that Pant relies on is that relevance is determined at the web page level (Pant, Column 1, Line 65 through Column 2, Line 25). This principle of operation would have to be changed to replicate the functionality of the claimed invention that measures keyword relevance.

Error #34) A third, closely related principle of operation that Pant relies on is that relevance is determined at the document level (Pant, Column 1, Line 65 through Column 2, Line 25). This principle of operation would have to be changed to replicate the functionality of the claimed invention that measures keyword relevance.

Because the required modifications of the Pant invention would change several of its principles of operation, the prima facie case of obviousness cannot be properly made.

Error 35 – It is well established that *when a modification of a reference destroys the intent, purpose or function of an invention such a proposed modification is not proper and the prima facie cause of obviousness cannot be properly made (In re Gordon 733 F.2d 900, 221 U.S.P.Q 1125 Fed Circuit 1984)*. Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the changes in the Pant invention that are required to duplicate the functionality described in claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 would destroy the intent, purpose and function of the invention include:

Error #35) The purpose of the Pant invention is to rank search results on the basis of user specified relevance factors (Pant, abstract). To that end, Pant relies on relevance measures defined by user identified factors and weights (Pant, abstract, Column 2, line 25 through line 36). As noted previously, this would have to change to replicate the functionality of the claimed invention that teaches and relies on the principle that keyword relevance is determined on the basis of the quantified impact on enterprise value.

Because the required modification of the Pant invention would destroy its intended function and purpose, the prima facie case of obviousness cannot be properly made.

Error 36 – *The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting In re Kahn 41 stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness (KSR, 550 U.S. at 1, 82 USPQ2d at 1396).*” In spite of this well know requirement, the Examiner has not provided the required explanation. In particular, the Examiner has not explained what would motivate someone of average skill in the art to destroy the functionality of the Pant invention and modify the principles of operation of both Sandretto and Pant as discussed under error 28, error 29, error 30 error 31, error 32, error 33, error 34 and error 35. This explanation is particularly important when one considers that Sandretto teaches away from all claimed methods and/or fails to teach or suggest almost every claim limitation as discussed under error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11,

error 12 error 13, error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 22, error 23, error 24, error 25, error 26 and error 27. In place of an explanation with articulated reasoning and a rational underpinning the Examiner has reached a conclusion of obviousness on the basis of several dozen errors in the facts and the law. Because no rational underpinning has been provided to support the legal conclusion of obviousness, the prima facie case of obviousness cannot be properly established.

Errors 37, 38 and 39 – The claim rejections are based on 35 U.S.C. §103(a) which states: *A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title [35 USC 102], if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.* Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for claim rejection include:

Error #37) Failure to acknowledge the fact that the cited documents fail to teach or suggest the subject matter as whole. As illustrated by the preceding discussion, the obviousness rejections appear to be based of a non-existent standard for obviousness “mentions the same word pairs as another document” instead of “teaches or suggests the subject matter as a whole” as there are no aspect of the rejected claims that are taught or suggested by the cited documents. It is also well established that the “*Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.*” *In re Lowry, 32 F.3d 1579, 1582 (Fed. Cir. 1994).* As detailed under errors 1 through 27, it does not appear that any of the limitations were actually considered.

Error #38) Failure to acknowledge the fact that the claim rejections have been authored by an individual(s) who appears to lack the level of skill in the art required to author such rejections. It is well established that the “*hypothetical ‘person having ordinary skill in the art’ to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art*” *Ex parte Hiyamizu, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988).* It is unlikely that anyone who understood the scientific and engineering principles applicable to the pertinent art would ever suggest Sandretto or Pant as a reference in support of an obviousness rejection for the claimed inventions for the reasons described previously

under errors 1 through 37.

Error #39) Failure to acknowledge the fact that the claim rejections are based on apparent misrepresentations regarding the teachings of the cited documents. These apparent misrepresentation may be a product of the fact that the Examiner does not appear to have the requisite level of skill in the relevant arts.

Errors 40 and 41 – In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of U.S.P.T.O. findings are the standards set forth in the Administrative Procedure Act (“APA”) at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include:

Error #40) Failure to acknowledge the fact that the claim rejections fail under the substantial evidence standard. Error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12, error 13, error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 22, error 23, error 24, error 25, error 26, error 27, error 28, error 29, error 30, error 31, error 32, error 33, error 34, error 35, error 36, error 37, error 38 and error 39 clearly show that the relevant Office Action fails to provide even a scintilla of evidence to support the obviousness rejections of all rejected claims and that as a result the rejections fail to meet the substantial evidence standard.

Error #41) Failure to acknowledge the fact that the claim rejections fail under the arbitrary and capricious standard. The Appellant respectfully submits that the obviousness rejection of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 also fails to pass the arbitrary and capricious test for a number of reasons including the fact that:

- a) as detailed above, the references cited by the Examiner provide substantial evidence of novelty, non-obviousness and newness of the rejected claims (see errors 1 through 35);
- b) no rational underpinning has been provided to support the legal conclusion of obviousness (see error 36),
- c) there is no rational connection between the statutory requirements for an obviousness rejection, the agency fact findings and the rejection of the claims (see errors 37 through 39), and
- d) prior agency fact-findings have shown that 35 U.S.C. 103 requirements for non-

obviousness are apparently not always considered during the prosecution and allowance of large company patent applications (i.e. U.S. Patent 7,092,918 and 7,240,109). This apparently unequal application of the law comprises an apparent violation of 35 USC 3.

Because the claim rejections do not meet either standard of the APA, the prima facie case of obviousness cannot be properly established. Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case of obviousness for a single claim. These failures provide additional evidence that the claimed inventions are new, novel and non-obvious.

Issue 2 – Whether claim 183, claim 184, claim 185, claim 186 and claim 187 are patentable under 35 U.S.C. 103(a) given Pant in view of Sandretto?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the cited combination of teachings (Pant and Sandretto) and the arguments related to the cited combination of teachings fail to establish a prima facie case of obviousness for every rejected claim as detailed below.

Errors 1 through 13 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the cited references teach away from the invention described in claim 183, claim 184, claim 185, claim 186 and claim 187 include, error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12 and error 13 identified under Issue 1.

Errors 14 through 24 - Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the cited documents (Pant and Sandretto) do not teach one or more limitations of the claimed invention include error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 23, error 24 and error 26 identified under Issue 1.

Errors 25, 26, 27 and 28 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that changes in the principles of operation of Sandretto will be required to replicate the invention described in claim 183, claim 184, claim 185, claim 186 and claim 187 include error 28, error 29, error 30 and error 31 identified under Issue 1.

Errors 29, 30 and 31 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that changes in the principles of operation of Pant will be required to replicate the invention described in claim 183, claim 184, claim 185, claim 186 and claim 187

include error 32, error 33 and error 34 identified under Issue 1.

Error 32 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the changes in the Pant invention required to replicate the functionality of the invention described in claim 183, claim 184, claim 185, claim 186 and claim 187 will destroy the functionality of the Pant invention include error 35 identified under Issue 1.

Error 33 – *The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting In re Kahn 41 stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness (KSR, 550 U.S. at 1, 82 USPQ2d at 1396).”* In spite of this well know requirement, the Examiner has not provided the required explanation. In particular, the Examiner has not explained what would motivate someone of average skill in the art to destroy the functionality of the Pant invention and modify the principles of operation of both Sandretto and Pant as discussed under error 25, error 26, error 27, error 28, error 29, error 30 error 31 and error 32. This explanation is particularly important when one considers that Sandretto teaches away from all claimed methods and/or fails to teach or suggest almost every claim limitation as discussed under error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12 error 13, error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 22, error 23 and error 24. In place of an explanation with articulated reasoning and a rational underpinning the Examiner has reached a conclusion of obviousness on the basis of several dozen errors in the facts and the law. Because no rational underpinning has been provided to support the legal conclusion of obviousness, the prima facie case of obviousness cannot be properly established.

Errors 34, 35 and 36 – Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for claim rejection include error 37, error 38 and error 39 identified under Issue 1:

Errors 37 and 38 – In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of U.S.P.T.O. findings are the standards set forth in the Administrative Procedure Act (“APA”) at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include:

Error #37) Failure to acknowledge the fact that the claim rejections fail under the substantial evidence standard. Error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12, error 13, error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 22, error 23, error 24, error 25, error 26, error 27, error 28, error 29, error 30, error 31, error 32, error 33, error 34, error 35 and error 36, clearly show that the relevant Office Action fails to provide even a scintilla of evidence to support the obviousness rejections of all rejected claims and that as a result the rejections fail to meet the substantial evidence standard.

Error #38) Failure to acknowledge the fact that the claim rejections fail under the arbitrary and capricious standard. The Appellant respectfully submits that the obviousness rejection of claim 183, claim 184, claim 185, claim 186 and claim 187 also fails to pass the arbitrary and capricious test for a number of reasons including the fact that:

- a) as detailed above, the references cited by the Examiner provide substantial evidence of novelty, non-obviousness and newness of the rejected claims (see errors 1 through 32);
- b) no rational underpinning has been provided to support the legal conclusion of obviousness (see error 33),
- c) there is no rational connection between the statutory requirements for an obviousness rejection, the agency fact findings and the rejection of the claims (see errors 34 through 36), and
- d) prior agency fact-findings have shown that 35 U.S.C. 103 requirements for non-obviousness are apparently not always considered during the prosecution and allowance of large company patent applications (i.e. U.S. Patent 7,283,982). This apparently unequal application of the law comprises an apparent violation of 35 USC 3.

Because the claim rejections do not meet either standard of the APA, the prima facie case of obviousness cannot be properly established.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case of obviousness for a single claim. These failures provide additional evidence that the claimed inventions are new, novel and non-obvious.

Issue 3 – Whether claim 188, claim 189, claim 190, claim 191 and claim 192 are patentable under 35 U.S.C. 103(a) given Pant in view of Sandretto?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the cited combination of teachings (Pant and Sandretto) and the arguments related to the cited combination of teachings fail to establish a prima facie case of obviousness for every rejected claim as detailed below.

Errors 1 through 13 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the cited references teach away from the invention described in claim 188, claim 189, claim 190, claim 191 and claim 192 include, error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12 and error 13 identified under Issue 1.

Errors 14 through 25 - Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the cited documents (Pant and Sandretto) do not teach one or more limitations of the claimed invention include error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 23, error 24 and error 26 identified under Issue 1.

Errors #25) Failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitation of claim 188 (affects claims 189, 190, 191 and 192), including: *searching for a plurality of keywords in one or more external databases and storing a location for each identified keyword (#25).*

Errors 26, 27, 28 and 29 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that changes in the principles of operation of Sandretto will be required to replicate the invention described in claim 188, claim 189, claim 190, claim 191 and claim 192 include error 28, error 29, error 30 and error 31 identified under Issue 1.

Errors 30, 31 and 32 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that changes in the principles of operation of Pant will be required to replicate the invention described in claim 188, claim 189, claim 190, claim 191 and claim 192 include error 32, error 33 and error 34 identified under Issue 1.

Error 33 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the changes in the Pant invention required to replicate the functionality of the invention described in claim 188, claim 189, claim 190, claim 191 and claim 192 will destroy the functionality of the Pant invention include error 35 identified under Issue 1.

Error 34 – *The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting In re Kahn 41 stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be*

some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness (KSR, 550 U.S. at 1, 82 USPQ2d at 1396)." In spite of this well know requirement, the Examiner has not provided the required explanation. In particular, the Examiner has not explained what would motivate someone of average skill in the art to destroy the functionality of the Pant invention and modify its principles of operation of as discussed under error 26, error 27, error 28, error 29, error 30 error 31, error 32 and error 33. This explanation is particularly important when one considers that Sandretto teaches away from all claimed methods and/or fails to teach or suggest almost every claim limitation as discussed under error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12 error 13, error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 22, error 23, error 24 and error 25. In place of an explanation with articulated reasoning and a rational underpinning the Examiner has reached a conclusion of obviousness on the basis of several dozen errors in the facts and the law. Because no rational underpinning has been provided to support the legal conclusion of obviousness, the prima facie case of obviousness cannot be properly established.

Errors 35, 36 and 37 – Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for claim rejection include error 37, error 38 and error 39 identified under Issue 1:

Errors 38 and 39 – In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of U.S.P.T.O. findings are the standards set forth in the Administrative Procedure Act (“APA”) at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include:

Error #38) Failure to acknowledge the fact that the claim rejections fail under the substantial evidence standard. Error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12, error 13, error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 22, error 23, error 24, error 25, error 26, error 27, error 28, error 29, error 30, error 31, error 32, error 33, error 34, error 35, error 36 and error 37, clearly show that the relevant Office Action fails to provide even a scintilla of evidence to support the obviousness rejections of all rejected claims and that as a result the rejections fail to meet the substantial evidence standard.

Error #39) Failure to acknowledge the fact that the claim rejections fail under the arbitrary and capricious standard. The Appellant respectfully submits that the obviousness rejection

of claim 188, claim 189, claim 190, claim 191 and claim 192 also fails to pass the arbitrary and capricious test for a number of reasons including the fact that:

- a) as detailed above, the references cited by the Examiner provide substantial evidence of novelty, non-obviousness and newness of the rejected claims (see errors 1 through 33);
- b) no rational underpinning has been provided to support the legal conclusion of obviousness (see error 34),
- c) there is no rational connection between the statutory requirements for an obviousness rejection, the agency fact findings and the rejection of the claims (see errors 35 through 37), and
- d) prior agency fact-findings have shown that 35 U.S.C. 103 requirements for non-obviousness are apparently not always considered during the prosecution and allowance of large company patent applications (i.e. U.S. Patent 7,283,982). This apparently unequal application of the law comprises an apparent violation of 35 USC 3.

Because the claim rejections do not meet either standard of the APA, the prima facie case of obviousness cannot be properly established.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case of obviousness for a single claim. These failures provide additional evidence that the claimed inventions are new, novel and non-obvious.

Issue 4 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 are patentable under 35 U.S.C. 103(a) given Pant in view of Sandretto?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the cited combination of teachings (Pant and Sandretto) and the arguments related to the cited combination of teachings fail to establish a prima facie case of obviousness for every rejected claim as detailed below.

Errors 1 through 13 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the cited references teach away from the invention described in claim 193, claim 194, claim 195, claim 196 and claim 197 include, error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12 and error 13 identified under Issue 1.

Errors 14 through 25 - Errors in the claim rejections caused by the apparent failure to

acknowledge the fact that the cited documents (Pant and Sandretto) do not teach one or more limitations of the claimed invention include error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 23, error 24 and error 26 identified under Issue 1.

Errors #25) Failure to acknowledge the fact that the cited documents do not teach or suggest one or more limitation of claim 193 (affects claims 194, 195, 196 and 197), including: *searching for a plurality of keywords in one or more external databases and storing a location for each identified keyword (#25).*

Errors 26, 27, 28 and 29 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that changes in the principles of operation of Sandretto will be required to replicate the invention described in claim 193, claim 194, claim 195, claim 196 and claim 197 include error 28, error 29, error 30 and error 31 identified under Issue 1.

Errors 30, 31 and 32 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that changes in the principles of operation of Pant will be required to replicate the invention described in claim 193, claim 194, claim 195, claim 196 and claim 197 include error 32, error 33 and error 34 identified under Issue 1.

Error 33 – Errors in the claim rejections caused by the apparent failure to acknowledge the fact that the changes in the Pant invention required to replicate the functionality of the invention described in claim 193, claim 194, claim 195, claim 196 and claim 197 will destroy the functionality of the Pant invention include error 35 identified under Issue 1.

Error 34 – *The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting In re Kahn 41 stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness (KSR, 550 U.S. at 1, 82 USPQ2d at 1396).”* In spite of this well know requirement, the Examiner has not provided the required explanation. In particular, the Examiner has not explained what would motivate someone of average skill in the art to destroy the functionality of the Pant invention and modify the principles of operation of both inventions (Pant and Sandretto) as discussed under error 26, error 27, error 28, error 29, error 30 error 31, error 32 and error 33. This explanation is particularly important when one considers that Pant and Sandretto teach away from all claimed methods and/or fails to teach or suggest almost every claim limitation as discussed under error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12 error 13, error 14, error 15, error 16, error 17, error 18,

error 19, error 20, error 21, error 22, error 23, error 24 and error 25. In place of an explanation with articulated reasoning and a rational underpinning the Examiner has reached a conclusion of obviousness on the basis of several dozen errors in the facts and the law. Because no rational underpinning has been provided to support the legal conclusion of obviousness, the prima facie case of obviousness cannot be properly established.

Errors 35, 36 and 37 – Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for claim rejection include error 37, error 38 and error 39 identified under Issue 1:

Errors 38 and 39 – In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of U.S.P.T.O. findings are the standards set forth in the Administrative Procedure Act (“APA”) at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include:

Error #38) Failure to acknowledge the fact that the claim rejections fail under the substantial evidence standard. Error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12, error 13, error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 22, error 23, error 24, error 25, error 26, error 27, error 28, error 29, error 30, error 31, error 32, error 33, error 34, error 35, error 36 and error 37, clearly show that the relevant Office Action fails to provide even a scintilla of evidence to support the obviousness rejections of all rejected claims and that as a result the rejections fail to meet the substantial evidence standard.

Error #39) Failure to acknowledge the fact that the claim rejections fail under the arbitrary and capricious standard. The Appellant respectfully submits that the obviousness rejection of claim 193, claim 194, claim 195, claim 196 and claim 197 also fails to pass the arbitrary and capricious test for a number of reasons including the fact that:

- a) as detailed above, the references cited by the Examiner provide substantial evidence of novelty, non-obviousness and newness of the rejected claims (see errors 1 through 33);
- b) no rational underpinning has been provided to support the legal conclusion of obviousness (see error 34),
- c) there is no rational connection between the statutory requirements for an obviousness rejection, the agency fact findings and the rejection of the claims (see

errors 35 through 37), and

d) prior agency fact-findings have shown that 35 U.S.C. 103 requirements for non-obviousness are apparently not always considered during the prosecution and allowance of large company patent applications (i.e. U.S. Patent 7,283,982). This apparently unequal application of the law comprises an apparent violation of 35 USC 3.

Because the claim rejections do not meet either standard of the APA, the prima facie case of obviousness cannot be properly established.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case of obviousness for a single claim. These failures provide additional evidence that the claimed inventions are new, novel and non-obvious.

Issue 5 - Whether claim 183, claim 184, claim 185, claim 186 and claim 187 represent patentable subject matter under 35 U.S.C. 101?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of non statutory subject matter for every rejected claim as detailed below.

Errors 1 and 2 - It is well established that *“the burden is on the U.S.P.T.O. to set forth a prima facie case of unpatentability. Therefore if U.S.P.T.O. personnel determine that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, they must provide an explanation.”*(See, e.g., *In re Nuijten*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip. Op. at 18)). Errors in the claim rejections caused by the apparent failure to establish a prima facie case of non statutory subject matter include:

Error #1) The rejection of independent claims 183 is based on a conclusory statement that the invention described in the claim does not include a transformation. The remaining claims are rejected because they depend on the rejected independent claim. In rejecting the claim, the Examiner failed to explain:

- a) why the transformation of organization related data into keyword performance indicators is not considered a transformation, and
- b) why the transformation of organization related data into a model of organization financial performance by category of value is not considered a transformation.

An explanation in this regard is particularly important given the fact that the Supreme Court and the CAFC (see *Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (2008)) have both

found the transformation of data regarding real world activities and/or objects into a different state or thing to be statutory subject matter. Bilski specifically found the transformation of data into a graph or picture to be statutory subject matter. The failure to provide an explanation supported to by evidence leads to the inevitable conclusion that the Examiner has failed to establish a prima facie case that would support a §101 rejection of claim 183, claim 184, claim 185, claim 186 and claim 187.

Error #2) The rejection of claim 183, claim 184, claim 185, claim 186 and claim 187 is based on a conclusory statement that the invention described in the claim does not include any transformations. In rejecting the claim, the Examiner failed to explain why a transformation is required after considering the fact that the Supreme Court has specifically stated “[a] process may be patentable irrespective of the particular form of the instrumentalities used” (*Cochrane v. Deener*, 94 U. S. 780). The failure to provide an explanation as to why a transformation is required in view of *Cochrane v Deener* leads to the inevitable conclusion that the Examiner has failed to establish a prima facie case that would support a §101 rejection of claim 183, claim 184, claim 185, claim 186 and claim 187.

The prima facie case of non statutory subject matter has not been properly established. Recognizing this clear error in the grounds for rejection will reverse the non statutory subject matter rejection of claim 183, claim 184, claim 185, claim 186 and claim 187.

Errors 3 and 4 – Additional errors in the rejections for non-statutory subject matter are the result of the fact that the claim rejections are based on a conclusory statement that is demonstrably false. Errors in the claim rejections caused by a reliance on apparently false conclusory statements include:

Error #3) As discussed under Error #1 and Error #2 of this Issue, claim 183, claim 184, claim 185, claim 186 and claim 187 are rejected for allegedly not completing a transformation. This conclusory statement is demonstrably false as the claimed invention organization related data into one or more keyword performance indicators.

Error #4) As discussed under Error #1 and Error #2 of this Issue, claim 183, claim 184, claim 185, claim 186 and claim 187 are rejected for allegedly not completing a transformation. This conclusory statement is demonstrably false as the claimed invention transforms organization related data into a model of organization financial performance by category of value.

The claim rejections are improper because they are based on conclusory statements that are incorrect. Recognizing this clear error in the grounds for rejection will reverse the non statutory subject matter rejection of claim 183, claim 184, claim 185, claim 186 and claim 187.

Errors 5 and 6 – The “*Supreme Court noted that one example of a statutory “process” is where the process steps provide a transformation or reduction of an article to a different state or thing (Diehr, 450 U.S. at 183, 209 USPQ at 6).* In Alappat, the Court held that “*data, transformed by a machine” “to produce a smooth waveform display” “constituted a practical application of an abstract idea.” State Street, 149 F.3d at 1373.* In Arrhythmia, the Court held “*the transformation of electrocardiograph signals” “by a machine” “constituted a practical application of an abstract idea.” Id.* Likewise, in State Street, the Court held that “*the transformation of data” “by a machine” “into a final share price, constitutes a practical application of a mathematical algorithm.” Id.* Thus, while Diehr involved the transformation of a tangible object – curing synthetic rubber – the Court also regards the transformation of intangible subject matter to similarly be eligible, so long as data represent some real world activity. In re Bilski, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (2008) generally follows these prior decisions and states that the data transformed by a process must represent an object or substance that physically exists.

Error #5) Is a failure to acknowledge that the rejected claims meet the statutory requirements for patentability. The rejected independent claims describe processes that transform data representative of an organization that physically exists into a different state or thing: one or more keyword performance indicators and a model of organization financial performance. As discussed in detail in the summary of claimed subject matter, the latter transformation uses the results of the first transformation. The keyword performance indicators and organization financial model have utility in analyzing, managing, measuring and optimizing the financial performance of an organization.

Error #6) Failure to acknowledge the fact that the claim rejections are based on apparent misrepresentations regarding the claimed invention. These apparent misrepresentation may be a product of the fact that the Examiner does not appear to have the requisite level of skill in the relevant arts.

The claim rejections are improper because the rejected claims meet all existing statutory requirements for patent eligible subject matter and because they appear to be based on misrepresentations regarding the claimed inventions. Recognizing these clear errors in the grounds for rejection will reverse the non-statutory subject matter rejection of claim 183, claim 184, claim 185, claim 186 and claim 187.

Errors 7 and 8 – In Dickinson v. Zurko, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of USPTO findings are the standards set forth in the Administrative Procedure Act (“APA”) at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include:

Error #7) Failure to acknowledge the fact that the claim rejections fail under the substantial evidence standard. Error 1, error 2, error 3, error 4, error 5 and error 6 clearly show that the relevant Office Action fails to provide even a scintilla of evidence to support the non statutory subject matter rejection of claim 183, claim 184, claim 185, claim 186 and claim 187 and that as a result the rejections fail to meet the substantial evidence standard.

Error #8) Failure to acknowledge the fact that the claim rejections fail under the arbitrary and capricious standard. The Appellant respectfully submits that the non statutory subject matter rejection of claim 183, claim 184, claim 185, claim 186 and claim 187 also fails to pass the arbitrary and capricious test for a number of reasons including the fact that:

- a) no rational underpinning has been provided to support the legal conclusion of non statutory subject matter (see errors 1 through 4). In particular, there is no rational connection between the purpose of the claimed inventions, the transformations completed by the claimed inventions and the statement that no transformations are being completed,
- b) there is no rational connection between the statutory requirements for non statutory subject matter rejections and the agency fact findings (see errors 5 and 6), and
- c) prior agency fact-findings have shown that 35 U.S.C. 101 requirements for statutory subject matter are apparently not always considered during the prosecution and allowance of large company patent applications. This apparently unequal application of the law comprises an apparent violation of 35 USC 3.

Because the claim rejections do not meet either standard of the APA, the prima facie case of non statutory subject matter can not be properly established. Recognizing this clear error in the grounds for rejection will reverse the non statutory subject matter rejection of claim 183, claim 184, claim 185, claim 186 and claim 187.

Issue 6 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 represent patentable subject matter under 35 U.S.C. 101?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of utility and/or non statutory subject matter for every rejected claim as detailed below.

Errors 1 and 2 - Errors in the claim rejections caused by the apparent failure to establish a prima facie case of non statutory subject matter include error 1 and error 2 identified under Issue 5.

Errors 3 and 4 – Errors in the claim rejections caused by a reliance on apparently false conclusory statements include error 3 and error 4 identified under Issue 5.

Errors 5 and 6 – Errors in the claim rejections caused by a failure to acknowledge that the rejected claims meet the statutory requirements for allowable subject matter include error 5 and error 6 identified under Issue 5.

Errors 7 and 8 – Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include error 7 and error 8 identified under Issue 5.

Because the claim rejections do not meet either standard of the APA, the prima facie case of non statutory subject matter and/or a lack of utility can not be properly established. Recognizing this clear error in the grounds for rejection will reverse the non statutory subject matter rejection of claim 193, claim 194, claim 195, claim 196 and claim 197.

Issue 7 - Whether claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 are enabled under 35 U.S.C. 112, first paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of enablement for every rejected claim as detailed below.

Errors 1 through 18 - It is well established that *“a description as filed is presumed to be adequate; unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion.*

These findings should: (A) Identify the claim limitation at issue; and (B) Establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of “unpredictability in the art” is not a sufficient reason to support a rejection for lack of adequate written description.” Furthermore, it is well established that “the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). This has been the primary test of enablement since 1916 (see Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916)). The determination that “undue experimentation” would have been needed to make and use the claimed invention is not a single, simple factual determination (In re Wands, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988)). Factors which need to be considered include: the nature of the invention, the state of the prior art, the predictability or lack thereof in the art, the amount of direction or guidance present, the presence or absence of working examples, the breadth of the claims, the relative skill of those in the art and the quantity of experimentation needed (hereinafter referred to as the Wands factors). A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors (the Wands factors), the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation (In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Errors in the claim rejections caused by the apparent failure to establish a prima facie case of a lack of enablement include:

Errors #1, #2, #3, #4, #5, #6, #7 and #8 – Is a failure to acknowledge that no evidence has been presented to support the rejection of claim 175 (#1), claim 176 (#2), claim 177 (#3), claim 178 (#4), claim 179 (#5), claim 180 (#6), claim 181 (#7) and claim 182 (#8). As noted above, rejection under §112 first paragraph requires a preponderance of evidence and express findings of fact. In spite of this well known requirement, no facts have been identified and no evidence has been presented that excessive experimentation would be required and/or that the full scope of the claimed invention has not been described.

Error #9, #10, #11, #12, #13, #14, #15 and #16 - Is a failure to acknowledge that the Wands factors have not been considered for claim 175 (#9), claim 176 (#10), claim 177 (#11), claim 178 (#12), claim 179 (#13), claim 180 (#14), claim 181 (#15) and claim 182 (#16). As noted above, rejection under §112 first paragraph requires a consideration of

the Wands factors. In spite of this well known requirement, the Examiner has not completed a single aspect of the required Wands factor analysis.

Error #17). Is a failure to acknowledge that no claim limitation(s) at issue have been identified. The Examiner has expressed vague concerns regarding the specification but no specific claim limitations have been identified as being at issue;

Error #18) Is a failure to acknowledge the evidence that has been presented. Evidence that the Examiner has apparently ignored includes:

- a) the summary of claimed subject matter;
- b) the fact that a large company was apparently able to copy several of the steps included in the specification – something that wouldn't have been possible if the specification was not enabling, and.
- c) the declarations submitted in support of this application, the declaration represents the only known independent review of the patent specification by someone with average skill in the relevant arts under either the pre or post KSR standards for determining the possession of said level of skill. Although the expert providing the declaration has considerable expertise in the development of models of real world entities, the Examiner has apparently chosen to ignore the contents of this declaration which states *“Specifically, U.S. Patent Application 10/746,673 together with the patent applications and patents it cross-references fully describes a performance model that quantifies and impact of a plurality of elements and sub-elements of value on a value of a business by category of value where the categories of value are selected from the group consisting of current operation, real option, market sentiment and combinations thereof (see pages 60 - 62, Evidence Appendix). The complete description of the performance model was contained in the cross referenced parent (09/940,450) of the instant, continuation application. The performance model comprises the organization financial model mentioned in each of the rejected independent claims.*

Since the prima facie case to support the claim rejections has not been established, no rebuttal was (or is) required.

Error 19 – An additional error in the claim rejections for a lack of enablement is the result of the fact that the claim rejections are based on a conclusory statement that is demonstrably false. As discussed in prior Office Actions, as detailed in the specification and as outlined in the Summary of Claimed Subject Matter the claimed method relies on data initially selected by a stepwise regression algorithm, the selected data are refined by induction algorithms and the data selected by these algorithms are used to build a final model. The conclusory statement that the claimed process is subjective is another indication that the individuals who authored and/or approved the relevant Office Action do not appear to understand the scientific and engineering

principles associated with the pertinent arts. The claim rejections are improper because they are based on a conclusory statement that is incorrect. Recognizing this clear error in the grounds for rejection will reverse the lack of enablement rejections of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Errors 20 and 21 – The claim rejections are based on 35 U.S.C. §112 first paragraph which states: *The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.* Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for an enablement rejection include:

Error #20) Failure to acknowledge the fact that the specification meets the requirements of 35 U.S.C. §112 first paragraph. As illustrated by the preceding discussion of errors 1 through 5, the enablement rejection appears to be based of a non-existent standard for written description enablement. As detailed under error 4, the rejected claims clearly and completely describe a process for measuring keyword relevance.

Error #21) Failure to acknowledge the fact that the claim rejections have been authored by individuals who appear to lack the level of skill in the art required to author such rejections. It is well established that the *“hypothetical ‘person having ordinary skill in the art’ to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art”* *Ex parte Hiyamizu, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988)*. It is unlikely that anyone who understood the scientific and engineering principles applicable to the pertinent art would ever suggest Sandretto or Pant as a reference in support of an obviousness rejection for the claimed inventions for the reasons described previously under Issue 1, Issue 2 and Issue 3. As noted previously, many of the 150 plus errors identified in the claim rejections appear to be based on a basic misunderstanding regarding the teachings of the Sandretto and Pant documents that may be another indication of the lack of understanding of the scientific and engineering principles applicable to the pertinent art.

Errors 22 and 23 – In *Dickinson v. Zurko, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999)*, the Supreme Court held that the appropriate standard of review of U.S.P.T.O. findings are the standards set forth in the Administrative Procedure Act (“APA”) at 5 U.S.C. 706 (1994). The

APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include:

Error #22) Failure to acknowledge the fact that the claim rejections fail under the substantial evidence standard. Error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12, error 13, error 14, error 15, error 16, error 17, error 18, error 19, error 20 and error 21 clearly show that the relevant Office Action fails to provide even a scintilla of evidence to support the lack of enablement rejections of all rejected claims and that as a result the rejections fail to meet the substantial evidence standard.

Error #23) Failure to acknowledge the fact that the claim rejections fail under the arbitrary and capricious standard. The Appellant respectfully submits that the enablement rejection of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 also fails to pass the arbitrary and capricious test for a number of reasons including the fact that:

- a) as detailed above under errors 1 through 19, the evidence clearly shows that there is no evidence to support the rejection of a single claim;
- b) there is no rational connection between the statutory requirements for enablement, the agency fact findings and the rejection of the claims (see errors 20 and 21),
- c) there is no rational connection between the rejection for a lack of enablement and the prior agency fact findings associated with U.S. Patent 7,283,982
- d) there is no rational connection between the rejection for alleged subjectivity and the prior agency fact findings associated with Pant, and
- e) prior agency fact-findings have shown that 35 U.S.C. 112 first paragraph requirements for enablement are apparently not always considered during the prosecution and allowance of large company patent applications (i.e. U.S. Patent 7,283,982). This apparently unequal application of the law comprises an apparent violation of 35 USC 3.

Because the claim rejections do not meet either standard of the APA, the prima facie case of a lack of enablement cannot be properly established.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima

facie case of a lack of enablement for a single claim. Recognizing these clear errors in the grounds for rejection will reverse the lack of enablement rejections of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182.

Issue 8 – Whether claim 183, claim 184, claim 185, claim 186 and claim 187 are enabled under 35 U.S.C. 112, first paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of enablement for every rejected claim as detailed below.

Errors 1 through 12 - Errors in the claim rejections caused by the apparent failure to establish a prima facie case of a lack of enablement include error 17 and error 18 identified under Issue 7. Additional errors include.

Errors #3, #4, #5, #6 and #7 – Is a failure to acknowledge that no evidence has been presented to support the rejection of claim 183 (#3), claim 184 (#4), claim 185 (#5), claim 186 (#6) and claim 187 (#7). As noted above, rejection under §112 first paragraph requires a preponderance of evidence and express findings of fact. In spite of this well known requirement, no facts have been identified and no evidence has been presented that excessive experimentation would be required and/or that the full scope of the claimed invention has not been described.

Error #8, #9, #10, #11 and #12 - Is a failure to acknowledge that the Wands factors have not been considered for claim 183 (#8), claim 184 (#9), claim 185 (#10), claim 186 (#11) and claim 187 (#12). As noted above, rejection under §112 first paragraph requires a consideration of the Wands factors. In spite of this well known requirement, the Examiner has not completed a single aspect of the required Wands factor analysis.

Error 13 – Errors in the claim rejections caused by a reliance on apparently false conclusory statements include error 19 identified under Issue 7.

Errors 14 and 15 – Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for an enablement rejection include error 20 and error 21 identified under issue 7.

Errors 16 and 17 – Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include error 22 and error 23 identified under Issue 7.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to

produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case of a lack of enablement for a single claim. Recognizing these clear errors in the grounds for rejection will reverse the lack of enablement rejections of claim 183, claim 184, claim 185, claim 186 and claim 187.

Issue 9 – Whether claim 188, claim 189, claim 190, claim 191 and claim 192 are enabled under 35 U.S.C. 112, first paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of enablement for every rejected claim as detailed below.

Errors 1 through 12 - Errors in the claim rejections caused by the apparent failure to establish a prima facie case of a lack of enablement include error 17 and error 18 identified under Issue 7. Additional errors include.

Errors #3, #4, #5, #6 and #7 – Is a failure to acknowledge that no evidence has been presented to support the rejection of claim 188 (#3), claim 189 (#4), claim 190 (#5), claim 191 (#6) and claim 192 (#7). As noted above, rejection under §112 first paragraph requires a preponderance of evidence and express findings of fact. In spite of this well known requirement, no facts have been identified and no evidence has been presented that excessive experimentation would be required and/or that the full scope of the claimed invention has not been described.

Error #8, #9, #10, #11 and #12 - Is a failure to acknowledge that the Wands factors have not been considered for claim 188 (#8), claim 189 (#9), claim 190 (#10), claim 191 (#11) and claim 192 (#12). As noted above, rejection under §112 first paragraph requires a consideration of the Wands factors. In spite of this well known requirement, the Examiner has not completed a single aspect of the required Wands factor analysis.

Error 13 – Errors in the claim rejections caused by a reliance on apparently false conclusory statements include error 19 identified under Issue 7.

Errors 14 and 15 – Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for an enablement rejection include error 20 and error 21 identified under issue 7.

Errors 16 and 17 – Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include error 22 and error 23 identified under Issue 7.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case of a lack of enablement for a single claim. Recognizing these clear errors in the grounds for rejection will reverse the lack of enablement rejections of claim 188, claim 189, claim 190, claim 191 and claim 192.

Issue 10 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 are enabled under 35 U.S.C. 112, first paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of a lack of enablement for every rejected claim as detailed below.

Errors 1 through 12 - Errors in the claim rejections caused by the apparent failure to establish a prima facie case of a lack of enablement include error 17 and error 18 identified under Issue 7. Additional errors include.

Errors #3, #4, #5, #6 and #7 – Is a failure to acknowledge that no evidence has been presented to support the rejection of claim 193 (#3), claim 194 (#4), claim 195 (#5), claim 196 (#6) and claim 197 (#7). As noted above, rejection under §112 first paragraph requires a preponderance of evidence and express findings of fact. In spite of this well known requirement, no facts have been identified and no evidence has been presented that excessive experimentation would be required and/or that the full scope of the claimed invention has not been described.

Error #8, #9, #10, #11 and #12 - Is a failure to acknowledge that the Wands factors have not been considered for claim 193 (#8), claim 194 (#9), claim 195 (#10), claim 196 (#11) and claim 197 (#12). As noted above, rejection under §112 first paragraph requires a consideration of the Wands factors. In spite of this well known requirement, the Examiner has not completed a single aspect of the required Wands factor analysis.

Error 13 – Errors in the claim rejections caused by a reliance on apparently false conclusory statements include error 19 identified under Issue 7.

Errors 14 and 15 – Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for an enablement rejection include error 20 and error 21 identified under issue 7.

Errors 16 and 17 – Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include error 22 and error 23 identified under Issue 7.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case of a lack of enablement for a single claim. Recognizing these clear errors in the grounds for rejection will reverse the lack of enablement rejections of claim 193, claim 194, claim 195, claim 196 and claim 197.

Issue 11 - Whether claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 are indefinite under 35 U.S.C. 112, second paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of claim indefiniteness for every rejected claim as detailed below.

Errors 1 through 32 – It is well established that: *the definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001).* Errors in the claim rejections caused by the apparent failure to establish a prima facie case of claim indefiniteness include:

Errors #1, #2, #3, #4, #5, #6, #7 and #8 Is a failure to acknowledge that all the terms used in rejected claim 175 (#1), claim 176 (#2), claim 177 (#3), claim 178 (#4), claim 179 (#5), claim 180 (#6), claim 181 (#7) and claim 182 (#8) all have well recognized meanings which allows the reader to infer the meaning of the entire phrase with reasonable confidence (see *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004).

Errors #9, #10, #11, #12, #13, #14, #15 and #16 – Is a failure to acknowledge that no evidence has been provided to indicate that rejected claim 175 (#9), claim 176 (#10), claim 177 (#11), claim 178 (#12), claim 179 (#13), claim 180 (#14), claim 181 (#15) and claim 182 (#16) do not *particularly point out or distinctly claim* the disclosed invention to someone of average skill in the art. As discussed previously and as detailed above and

below, all the claim rejections are based on conclusory statements. Furthermore, there is substantial evidence that the conclusory statements were authored and approved by individuals who do not appear to have the requisite level of skill in the relevant arts.

Errors #17, #18, #19, #20, #21, #22, #23 and #24 - Is a failure to acknowledge that “*there is no requirement that the words in the claim must match those used in the specification disclosure,*” and “*Obviously, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite.*” MPEP §2173.02 states: “*Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.*” (see *In re Robert Skvorecz*, CAFC 2008-1221). Furthermore, there was a related failure to acknowledge that rejected claim 175 (#17), claim 176 (#18), claim 177 (#19), claim 178 (#20), claim 179 (#21), claim 180 (#22), claim 181 (#23) and claim 182 (#24) do not contain a term that does not have proper antecedent basis where such basis is not otherwise present by implication or the meaning is not reasonably ascertainable (*Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1255,85 USPQ2d 1663 (Fed. Cir. 2008) and *Halliburton*, 514 F.3d at 1246, 85 USPQ2d at 1658 (Citing *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir, 2007).

Errors #25, #26, #27, #28, #29, #30, #31 and #32 – Is a failure to acknowledge that the specification describes the metes and bounds of rejected: rejected claim 175 (#25), claim 176 (#26), claim 177 (#27), claim 178 (#28), claim 179 (#29), claim 180 (#30), claim 181 (#31) and claim 182 (#32).

Errors 33 and 34 – The claim rejections are based on 35 U.S.C. §112 second paragraph which states: *The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.* Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for an indefinite claim rejection include:

Error #33) Failure to acknowledge the fact that the rejected claims meet the requirements of 35 U.S.C. §112 second paragraph. As illustrated by the preceding discussion of errors 1 through 32, the enablement rejection appears to be based on an unknown and non-existent standard for claim definiteness.

Error #34) Failure to acknowledge the fact that the claim rejections have been authored by individuals who appear to lack the level of skill in the art required to author such

rejections. It is well established that the “hypothetical ‘person having ordinary skill in the art’ to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art” *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988). It is unlikely that anyone who understood the scientific and engineering principles applicable to the pertinent art would ever suggest Sandretto and Pant references in support of an obviousness rejection for the claimed inventions for the reasons described previously under Issue 1, Issue 2, Issue 3 and Issue 4. Another indication of the apparent lack of understanding of the scientific and engineering principles applicable to the pertinent art is the arbitrary and capricious rejection of the pending claims for alleged subjectivity.

Errors 35 and 36 – In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of U.S.P.T.O. findings are the standards set forth in the Administrative Procedure Act (“APA”) at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include:

Error #35) Failure to acknowledge the fact that the claim rejections fail under the substantial evidence standard. Error 1, error 2, error 3, error 4, error 5, error 6, error 7, error 8, error 9, error 10, error 11, error 12, error 13, error 14, error 15, error 16, error 17, error 18, error 19, error 20, error 21, error 22, error 23, error 24, error 25, error 26, error 27, error 28, error 29, error 30, error 31, error 32, error 33 and error 34 clearly show that the relevant Office Action fails to provide even a scintilla of evidence to support the rejections for indefiniteness for claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 and that as a result the rejections fail to meet the substantial evidence standard.

Error #36) Failure to acknowledge the fact that the claim rejections fail under the arbitrary and capricious standard. The Appellant respectfully submits that the rejection of claim 175, claim 176, claim 177, claim 178, claim 179, claim 180, claim 181 and claim 182 for indefiniteness also fails to pass the arbitrary and capricious test for a number of reasons including the fact that:

- a) as detailed above under errors 1 through 32, there is no evidence that the claims are indefinite;
- b) there is no rational connection between the statutory requirements for definiteness,

the agency fact findings and the rejection of the claims (see errors 33 and 34),
c) there is no rational connection between the rejection for claim indefiniteness and the prior agency fact findings associated with U.S. Patent 7,283,982,
d) there is no rational connection between the rejection for claim indefiniteness and the prior agency fact findings associated with Pant, and
e) prior agency fact-findings have shown that 35 U.S.C. 112 second paragraph requirements for enablement are apparently not always considered during the prosecution and allowance of large company patent applications (i.e. U.S. Patent 7,283,982). This apparently unequal application of the law comprises an apparent violation of 35 USC 3.

Because the claim rejections do not meet either standard of the APA, the prima facie case of claim indefiniteness cannot be properly established.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case that a single claim is indefinite.

Issue 12 – Whether claim 183, claim 184, claim 185, claim 186 and claim 187 are indefinite under 35 U.S.C. 112, second paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of claim indefiniteness for every rejected claim as detailed below.

Errors 1 through 20 – Errors in the claim rejections caused by the apparent failure to establish a prima facie case of claim indefiniteness include:

Errors #1, #2, #3, #4 and #5) Is a failure to acknowledge that all the terms used in rejected claim 183 (#1), claim 184 (#2), claim 185 (#3), claim 186 (#4) and claim 187 (#5) all have well recognized meanings which allows the reader to infer the meaning of the entire phrase with reasonable confidence (*see Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004)).

Errors #6, #7, #8, #9 and #10) – Is a failure to acknowledge that no evidence has been provided to indicate that rejected claim 183 (#6), claim 184 (#7), claim 185 (#8), claim 186 (#9) and claim 187 (#10) do not *particularly point out or distinctly claim* the disclosed invention to someone of average skill in the art. As discussed previously and as detailed above and below, all the claim rejections are based on conclusory statements.

Furthermore, there is substantial evidence that the conclusory statements were authored and approved by individuals who do not appear to have the requisite level of skill in the relevant arts.

Errors #11, #12, #13, #14 and #15 - Is a failure to acknowledge that *“there is no requirement that the words in the claim must match those used in the specification disclosure,”* and *“Obviously, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite.”* MPEP §2173.02 states: *“Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.”* (see *In re Robert Skvorecz*, CAFC 2008-1221). Furthermore, there was a related failure to acknowledge that rejected claim 183 (#11), claim 184 (#12), claim 185 (#13), claim 186 (#14) and claim 187 (#15) do not contain a term that does not have proper antecedent basis where such basis is not otherwise present by implication or the meaning is not reasonably ascertainable (*Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1255, 85 USPQ2d 1663 (Fed. Cir. 2008) and *Halliburton*, 514 F.3d at 1246, 85 USPQ2d at 1658 (Citing *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir, 2007)).

Errors #16, #17, #18, #19 and #20 – Is a failure to acknowledge that the specification describes the metes and bounds of rejected: rejected claim 183 (#16), claim 184 (#17), claim 185 (#18), claim 186 (#19) and claim 187 (#20).

Errors 21 and 22 – Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for an indefinite claim rejection include error 33 and error 34 identified under Issue 11.

Errors 23 and 24 – Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include error 35 and error 36 identified under Issue 11. Because the claim rejections do not meet either standard of the APA, the prima facie case of claim indefiniteness cannot be properly established.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case that a single claim is indefinite.

Issue 13 – Whether claim 188, claim 189, claim 190, claim 191 and claim 192 are indefinite under 35 U.S.C. 112, second paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the

facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of claim indefiniteness for every rejected claim as detailed below.

Errors 1 through 20 – Errors in the claim rejections caused by the apparent failure to establish a prima facie case of claim indefiniteness include:

Errors #1, #2, #3, #4 and #5) Is a failure to acknowledge that all the terms used in rejected claim 188 (#1), claim 189 (#2), claim 190 (#3), claim 191 (#4) and claim 192 (#5) all have well recognized meanings which allows the reader to infer the meaning of the entire phrase with reasonable confidence (*see Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004)).

Errors #6, #7, #8, #9 and #10) – Is a failure to acknowledge that no evidence has been provided to indicate that rejected claim 188 (#6), claim 189 (#7), claim 190 (#8), claim 191 (#9) and claim 192 (#10) do not *particularly point out or distinctly claim* the disclosed invention to someone of average skill in the art. As discussed previously and as detailed above and below, all the claim rejections are based on conclusory statements. Furthermore, there is substantial evidence that the conclusory statements were authored and approved by individuals who do not appear to have the requisite level of skill in the relevant arts.

Errors #11, #12, #13, #14 and #15) - Is a failure to acknowledge that *“there is no requirement that the words in the claim must match those used in the specification disclosure,”* and *“Obviously, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite.”* MPEP §2173.02 states: *“Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.”* (*see In re Robert Skvorecz, CAFC 2008-1221*). Furthermore, there was a related failure to acknowledge that rejected claim 188 (#11), claim 189 (#12), claim 190 (#13), claim 191 (#14) and claim 192 (#15) do not contain a term that does not have proper antecedent basis where such basis is not otherwise present by implication or the meaning is not reasonably ascertainable (*Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1255, 85 USPQ2d 1663 (Fed. Cir. 2008) and *Halliburton*, 514 F.3d at 1246, 85 USPQ2d at 1658 (Citing *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir, 2007)).

Errors #16, #17, #18, #19 and #20) – Is a failure to acknowledge that the specification describes the metes and bounds of rejected: rejected claim 188 (#16), claim 189 (#17), claim 190 (#18), claim 191 (#19) and claim 192 (#20).

Errors 21 and 22 – Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for an indefinite claim rejection include error 33 and error 34 identified under Issue 11.

Errors 23 and 24 – Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include error 35 and error 36 identified under Issue 11. Because the claim rejections do not meet either standard of the APA, the prima facie case of claim indefiniteness cannot be properly established.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case that a single claim is indefinite.

Issue 14 - Whether claim 193, claim 194, claim 195, claim 196 and claim 197 are indefinite under 35 U.S.C. 112, second paragraph?

The claims are patentable because the claim rejections are based on a number of errors in the facts and in the law. Because of these errors, the arguments presented by the Examiner fail to establish a prima facie case of claim indefiniteness for every rejected claim as detailed below.

Errors 1 through 20 –Errors in the claim rejections caused by the apparent failure to establish a prima facie case of claim indefiniteness include:

Errors #1, #2, #3, #4 and #5) Is a failure to acknowledge that all the terms used in rejected claim 193 (#1), claim 194 (#2), claim 195 (#3), claim 196 (#4) and claim 197 (#5) all have well recognized meanings which allows the reader to infer the meaning of the entire phrase with reasonable confidence (*see Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004).

Errors #6, #7, #8, #9 and #10) – Is a failure to acknowledge that no evidence has been provided to indicate that rejected claim 193 (#6), claim 194 (#7), claim 195 (#8), claim 196 (#9) and claim 197 (#10) do not *particularly point out or distinctly claim* the disclosed invention to someone of average skill in the art. As discussed previously and as detailed above and below, all the claim rejections are based on conclusory statements. Furthermore, there is substantial evidence that the conclusory statements were authored and approved by individuals who do not appear to have the requisite level of skill in the relevant arts.

Errors #11, #12, #13, #14 and #15) - Is a failure to acknowledge that *“there is no requirement that the words in the claim must match those used in the specification*

*disclosure,” and “Obviously, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite.” MPEP §2173.02 states: “Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.” (see *In re Robert Skvorecz*, CAFC 2008-1221). Furthermore, there was a related failure to acknowledge that rejected claim 193 (#11), claim 194 (#12), claim 195 (#13), claim 196 (#14) and claim 197 (#15) do not contain a term that does not have proper antecedent basis where such basis is not otherwise present by implication or the meaning is not reasonably ascertainable (*Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1255,85 USPQ2d 1663 (Fed. Cir. 2008) and *Halliburton*, 514 F.3d at 1246, 85 USPQ2d at 1658 (Citing *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir, 2007).*

Errors #16, #17, #18, #19 and #20 – Is a failure to acknowledge that the specification describes the metes and bounds of rejected: rejected claim 193 (#16), claim 194 (#17), claim 195 (#18), claim 196 (#19) and claim 197 (#20).

Errors 21 and 22 – Errors in the claim rejections caused by the apparent failure to meet any of the statutory requirements for an indefinite claim rejection include error 33 and error 34 identified under Issue 11.

Errors 23 and 24 – Errors in the claim rejections caused by the apparent failure to meet any of the requirements of the APA include error 35 and error 36 identified under Issue 11. Because the claim rejections do not meet either standard of the APA, the prima facie case of claim indefiniteness cannot be properly established.

Summarizing the above, the Appellant respectfully submits that the Examiner has failed to produce the evidence required to satisfy the requirements of the APA and/or establish a prima facie case that a single claim is indefinite.

8. Conclusion

The Appellant notes that with respect to the prosecution of the instant application, it appears that the U.S.P.T.O. has not fully complied with the requirements set forth in the APA, 35 U.S.C. 3 and 35 U.S.C. 131. A valid patent application rejection requires substantial evidence (Gartside, 203 F.3d at 1312). As described in the preceding section, the November 12, 2008 Office Action does not contain any evidence that would support the rejection of a single claim. However, related appeals and the November 12, 2008 Office Action for the instant application do provide substantial evidence that: those authoring/signing the Office Action do not appear to understand any of the scientific and/or engineering principles applicable to the pertinent art. Furthermore, those authoring the Office Action do not appear to adhere to any of the well established statutory requirements for authoring valid claim rejections and those authoring the relevant Office Action appear to have based the claim rejections on the application legal standards that are not applied during the review and allowance of similar applications filed by larger companies.

For the reasons detailed above, the Appellant respectfully but forcefully contends that each claim is patentable. Therefore, reversal of all rejections is courteously solicited.

Respectfully submitted,
Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President,

Dated: September 14, 2009

9. Claims Appendix

175. A program storage device readable by a computer, tangibly embodying a program of instructions executable by at least one computer to perform the method steps in a data processing method, comprising:

integrating a plurality of data from a plurality of organization related systems, user input and an Internet in accordance with a common schema and an xml metadata standard,
obtaining one or more keywords and a set of classification rules for each keyword from a user,
searching for a plurality of keywords on the Internet,
storing a location for each identified keyword,
counting and classifying each stored keyword,
creating one or more keyword performance indicators, and
developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators, and using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization

where keyword performance indicators are linked together when they are not independent.

176. The program storage device of claim 175, wherein at least some data are pre-specified for integration and conversion

177. The program storage device of claim 175, wherein a plurality of integrated enterprise data are stored in an application database in accordance with a common schema.

178. The program storage device of claim 175, wherein a plurality of organization related systems are selected from the group consisting of advanced financial systems, basic financial systems, alliance management systems, brand management systems, customer relationship management systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling systems, supply chain systems, quality control systems, purchasing systems, risk management systems and combinations thereof.

179. The program storage device of claim 175, wherein a common schema identifies data designations selected from the group consisting of components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof.

180. The program storage device of claim 175, wherein a data processing method further comprises storing a plurality of converted data in one or more tables to support organization processing.

181. The program storage device of claim 175, wherein each keyword maps to the common schema.

182. The program storage device of claim 175, wherein the program storage device comprises one or more intelligent agents.

183. A computer implemented method for determining the relevance of a keyword, comprising:
integrating a plurality of data from a plurality of organization related systems, user input and an Internet in accordance with a common schema and an xml metadata standard,
obtaining one or more keywords and a set of classification rules for each keyword from a user,
searching for a plurality of keywords on the Internet,
storing a location for each identified keyword,
counting and classifying each stored keyword,
creating one or more keyword performance indicators,
developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators, and
using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization
where keyword performance indicators are linked together when they are not independent.

184. The method of claim 183, wherein at least some data are pre-specified for integration and conversion

185. The method of claim 183, wherein a plurality of organization related systems are selected from the group consisting of advanced financial systems, basic financial systems, alliance management systems, brand management systems, customer relationship management

systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling systems, supply chain systems, quality control systems, purchasing systems, risk management systems and combinations thereof.

186. The method of claim 183, wherein a common schema identifies data designations selected from the group consisting of components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof.

187. The method of claim 183, wherein each keyword maps to the common schema.

188. A keyword relevance system, comprising:

networked computers each with a processor having circuitry to execute instructions; a storage device available to each processor with sequences of instructions stored therein, which when executed cause the processors to:

integrate a plurality of data from a plurality of organization related systems, user input, an Internet and one or more external databases in accordance with a common schema and an xml metadata standard,

obtaining one or more keywords and a set of classification rules for each keyword from a user,

search for a plurality of keywords on the Internet and in one or more external databases,

store a location for each identified keyword,

count and classify each stored keyword,

create one or more keyword performance indicators,

develop a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators, and

use the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization

where keyword performance indicators are linked together when they are not independent.

189. The system of claim 188, wherein at least some data are pre-specified for integration and conversion

190. The system of claim 188, wherein a plurality of organization related systems are selected from the group consisting of advanced financial systems, basic financial systems, alliance management systems, brand management systems, customer relationship management systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling systems, supply chain systems, quality control systems, purchasing systems, risk management systems and combinations thereof.

191. The system of claim 188, wherein a common schema identifies data designations selected from the group consisting of components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof.

192. The system of claim 188, wherein each keyword maps to the common schema.

193. A computer implemented keyword relevance method, comprising:

integrating a plurality of data from a plurality of organization related systems, user input, an Internet and one or more external databases in accordance with a common schema and an xml metadata standard,

obtaining one or more keywords and a set of classification rules for each keyword from a user,

searching for a plurality of keywords on the Internet and in one or more external databases,

storing a location for each identified keyword,

counting and classifying each stored keyword,

creating one or more keyword performance indicators,

developing a model of organization financial performance by category of value that quantifies an impact of each of one or more keyword performance indicators, and

using the quantified impact of each keyword indicator as a measure of a relevance of each keyword to the organization

where keyword performance indicators are linked together when they are not independent.

194. The method of claim 193, wherein at least some data are pre-specified for integration and conversion

195. The method of claim 193, wherein a plurality of organization related systems are selected from the group consisting of advanced financial systems, basic financial systems, alliance management systems, brand management systems, customer relationship management systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling systems, supply chain systems, quality control systems, purchasing systems, risk management systems and combinations thereof.

196. The method of claim 193, wherein a common schema identifies data designations selected from the group consisting of components of value, sub components of value, known value drivers, elements of value, sub elements of value, non-relevant attributes and combinations thereof.

197. The method of claim 193, wherein each keyword maps to the common schema.

10. Evidence Appendix

Page 59 table comparing the claimed invention and the cited prior art

Pages 60 - 62 declaration under Rule 132 first submitted June 29, 2008

Teaching	10/750,792	Pant	Sandretto
Analysis type:	Keyword/Organization	Document/User	Item/Portfolio
Model type	Causal predictive	Scoring	Non causal, discounted cash flow
First stage	Prompt the user to identify keywords	Prompt the user to complete a search	Reduce an error measure by <u>adjusting an input parameter value</u> at the item level in a value model
Second stage	Develop keyword indicators for use as input variables	Receive a set of search result items from a query	None
Third stage	Select input variables that make the most significant contribution to the relevance of a value model using stepwise regression	Prompt the user to identify the relevance factors and weights that will be used to evaluate search result relevance	None
Fourth stage	Identify causal input variables and select the best set of variables using cross validation	Determine a weight for each attribute of each item in the search query based on the input supplied in the third stage	None
Fifth stage	Use the best variables in a plurality of models and select the model with lowest error	Sum the weights for all the attributes for each item to determine a relevance score for each item	None
Sixth stage	Output the keyword indicators and weights (if any) from best model as a relevance measure for the keyword	Sort and display the set of search result items from the first stage according to the relevance score	None

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/746,673
Applicant : Jeff S. Eder
Filed : January 18, 2001
Art Unit :: 3629
Examiner : Freda Nelson
Docket No. : AR - 62
Customer No. : 53787

DECLARATION UNDER RULE 132

I, Rick Rauenzahn, do hereby declare and say:

My home address is 529 Calle don Leandro, Espanola, New Mexico; I have a B.S. degree in chemical engineering from Lehigh University, an S.M. degree in chemical engineering from The Massachusetts Institute of Technology and a Ph.D. in chemical engineering from The Massachusetts Institute of Technology;

I have worked in the mathematical modeling field for 25 years, concentrating in the disciplines of fluid mechanics, turbulence modeling, numerical methods for partial differential equations, radiation hydrodynamics, and strength of materials. I also have extensive knowledge of computer system administration, particularly for Windows-based, Linux, and Unix systems; I have been employed by Los Alamos National Laboratory and Molten Metal Technologies for the past 23 years.

I further declare that I do not have any direct affiliation with the application owner, Asset Reliance, Inc. I met the inventor for the first time in April 2006. I joined the Technical Advisory Board for Knacta, Inc., a company run by the inventor in May of 2006. I have never discussed this patent application or any of the other patent applications owned by Asset Reliance with the inventor. Knacta, Inc. has a license to the intellectual property associated with this application.

On July 29, 2006, I was given a copy of U.S. Patent Application 10/746,673 entitled "an interactive sales performance management system" filed in the United States Patent Office on December 24, 2003 as well as the cross referenced application 09/940,450, filed August 29, 2001. Until that time I had not read either of these two patent applications. I have studied the entire specification in order to closely analyze the claims and drawings. I am totally familiar with the language of the claims and conversant with the scope thereof. I completely understand the invention as claimed.

Based on my experience and training in the field of mathematical modeling and electronic data processing, I have concluded that it would be straightforward for anyone of average skill in the relevant arts to duplicate the interactive sales performance management system using the information in U.S. Patent Application 10/746,673 together with the patent application it cross-references.

Specifically, U.S. Patent Application 10/746,673 together with the patent application and patent it cross-references fully describes:

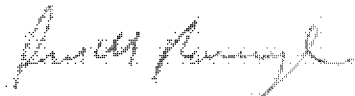
- 1) A performance model that quantifies and impact of a plurality of elements and subelements of value on a value of a business by category of value where the categories of value are selected from the group consisting of current operation, real option, market sentiment and combinations thereof;

Based on these and other considerations, it is my professional opinion that U.S. Patent Application 10/746,673 together with the patent application and patent it cross-references could be used to recreate and practice a method of and system for interactive sales performance management as claimed.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patents issuing thereon.

Signed,

/Rick M. Rauenzahn/



Rick Rauenzahn

Date: September 27, 2006

11. Related Proceedings Appendix (None)